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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,883	11/08/2000	Naohiko Matsuda	PM272992	1379

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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 07/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/707,883

Applicant(s)

MATSUDA ET AL.

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/294,713.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 11/8/00 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Objections***

2. Claims 1 and 3 are objected to because of the following informalities: “come” should be changed to --brought-- in line 8 of claim 1; --a-- should be inserted before “predetermined” in line 4 of claim 3; Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 3, it is unclear what is meant by “said adhesive surface down”. Do Applicants mean that the adhesive surface is down so as to be in contact with the support body or do Applicants mean that the tape is positioned on a bottom surface of a support body such that the adhesive surface is exposed and faces downward? Applicants are asked to clarify. If Applicants mean the former, it is suggested to redraft the claim to state --disposing the adhesive

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tape having an adhesive surface on a support body with said adhesive surface down so as to be in contact with said support body--.

Also regarding claim 1, it recites the limitation "the other not-adhesive surface" in line 6. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this phrase to --an opposite, not-adhesive surface--.

Also regarding claim 1, it is unclear what is meant by "on a surface of a member to be attached" since the tape is attached to the member and not vice versa. Applicants are asked to clarify. It is suggested to delete "to be attached" in lines 10 and 19.

Regarding claim 2, it is unclear what is meant by "said support body is constructed by a conveyor belt conducted with a reduction treatment". Applicants are asked to clarify. It is suggested to redraft the claim to state --said support body comprises a conveyor belt subjected to a reduction treatment--.

Regarding claim 3, it is unclear what is meant by "roll-like". Is the adhesive a roll or not? Applicants are asked to clarify. It is suggested to change this to --roll-form--.

Also regarding claim 3, it is unclear what is meant by "said adhesive surfaces down". Do Applicants mean that the adhesive surfaces are down so as to be in contact with the conveyor belt? Applicants are asked to clarify. It is suggested to redraft the claim to state --wherein the adhesive tape pieces are disposed one by one on said conveyor belt with their adhesive surfaces down so as to be in contact with said conveyor belt--.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindstrom et al. (US 4321103) optionally in view of Kuhnhold et al. (US 5413656).

With respect to claim 1, Lindstrom et al., directed to attaching an adhesive label (tape) 30, teaches disposing the tape having an adhesive surface (column 2, lines 37-38) on/between conveyor belts 38, 40 with the adhesive surface down so as to be in contact with the conveyor belt 40 (Figure 3; column 2, lines 45-56), rolling an attaching roller 44 on the not-adhesive surface of the tape so that the tape is transferred onto the roller and brought into tight contact therewith (Figure 3; column 2, lines 55-63), and rolling the roller on a surface of a member 75 so that the tape is attached to the surface of the member (Figure 3; column 4, lines 26-30).

The reference teaches the conveyor belts being coated with silicone or being totally fabricated of silicone so that the tape can be supported in an adhesive face-down position and be successfully peeled off the conveyor by the attaching roller (column 2, lines 45-57). Therefore, one of ordinary skill in the art at the time the invention was made would have appreciated that the adhesive strength between the conveyor and the adhesive surface of the tape is less than the adhesive strength between the not-adhesive surface of the tape and the attaching roller; it being noted that the present invention also teaches coating the conveyor with silicone to achieve the desired adhesive strength (page 7, lines 20-25). Since the tape is easily removed from the attaching roller when its adhesive surface contacts the surface of the member, one of ordinary skill in the art at the time the invention was made would have appreciated that the adhesive

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strength between the not-adhesive surface of the tape and the attaching roller is less than the adhesive strength between the adhesive surface of the tape and the member.

If it is not taken that the attaching roller has a lower degree of adhesion than the member with respect to the tape, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the surface of the attaching roller of Lindstrom et al. such that its degree of adhesion is less than that of the member because such is known in the art, as taught by Kuhnhold et al. (Figure 2; column 1, lines 62-63; column 3, lines 35-45; column 4, lines 10-18 and 64-68), wherein the expected results of the tape being removed from the roller and attached to the member would have been achieved.

Regarding claim 2, Lindstrom et al. teaches the conveyor belts being coated with silicone to reduce adhesivity between the adhesive surface of the tape and the conveyor belts (column 2, lines 45-55).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lindstrom et al. and optionally Kuhnhold et al. as applied to claim 2 above, and further in view of Adachi (US 4468274).

Regarding claim 3, Lindstrom teaches adhesive tape pieces 30 being attached to release web 28, wherein the web 28 is removed prior to disposing the tape pieces on the conveyor belts, and being wound on reel 26 (Figure 1; column 2, lines 20-23) but is silent as to how the tape pieces are formed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the adhesive tape be a continuous strip attached to the web 28 and wound on reel 26 followed by cutting the adhesive tape into adhesive pieces 30 after the web 28 is peeled from the tape (column 2, lines 20-36) but prior to disposing the pieces on the conveyor

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belts because such is known in the art, as taught by Adachi (Figure 2; column 2, lines 56-58 and 66; column 3, lines 18-26 and 55-58), wherein this would eliminate the need to make the adhesive pieces at a location remote from the tape-applying apparatus.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi  
Patent Examiner  
Art Unit 1733



jlr  
June 28, 2002



Michael W. Ball  
Supervisory Patent Examiner  
Technology Center 1700